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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,162	03/10/2004	John R. Pendray	S01.12-1010/STL 11723	4071
7590	03/08/2005			EXAMINER
Bryan F. Erickson Westman, Champlin & Kelly Suite 1600 900 Second Avenue South Minneapolis, MN 55402-3319			RENNER, CRAIG A	
			ART UNIT	PAPER NUMBER
			2652	
			DATE MAILED: 03/08/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/797,162	PENDRAY ET AL.	
Examiner	Art Unit		
Craig A. Renner	2652		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 December 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-38 is/are pending in the application.  
4a) Of the above claim(s) 18-20,24,27,28 and 36-38 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) \_\_\_\_\_ is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) 1-17,21-23,25,26 and 29-35 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_ .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

1. Applicant's election with traverse of "species II," upon which "Claims 1-23 and 25-38" are said to be "readable," in the reply filed on 02 December 2004 is acknowledged. Claims 18-20, 27-28, and 36-38, however, do not read on elected species II as elected species II does not include "wherein the responsive aeroelastic deposit is comprised on a side surface of the slider" as per claim 18, "wherein the responsive aeroelastic deposit is comprised on a leading surface of the slider" as per claim 19, "wherein the responsive aeroelastic deposit is comprised on a trailing surface of the slider" as per claim 20, "wherein the responsive aeroelastic deposit ... causes a lift of the slider to increase" as per claims 27-28, "wherein the responsive aeroelastic deposit is shaped to increase the lift" as per claim 36, "wherein the responsive aeroelastic deposit is shaped to increase a lift" as per claim 37, and "wherein the responsive aeroelastic deposit is shaped to decrease the lift" as per claim 38. Non-elected species V of FIG. 10 includes a responsive aeroelastic deposit 1046 on a side surface 1026 of a slider 1010, a responsive aeroelastic deposit 1042 on a leading surface 1022 of the slider, and a responsive aeroelastic deposit 1044 or 1045 on a trailing surface 1024 of the slider. Non-elected species I of FIGS. 1-2 includes a responsive aeroelastic deposit 38 which affects lift as detailed in lines 13-21 on page 14, for instance.

The traversal is on the ground(s) that "all claims are consistent with and applicable to each of the identified species, such that the subject matter of each claim is either explicitly depicted or could be applied to each identified species within the scope of the claimed invention." This argument, however, is not found to be persuasive because each of the various disclosed species details a mutually exclusive

characteristic of a slider as evidenced by the representation of each various species with a different figure or set of figures. A search for one of these mutually exclusive characteristics is not coextensive with a search for the other mutually exclusive characteristics and therefore searching for all mutually exclusive characteristics could not be done without serious burden.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 18-20, 24, 27-28, and 36-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim.

2. Upon further consideration and light of applicant's amendments/remarks, this application species contains claims directed to the following patentably distinct subspecies of the claimed invention:

Stimulus Response Subspecies:

Subspecies 1a - Deposit shears.  
Subspecies 1b - Deposit bends.  
Subspecies 1c - Deposit expands linearly.

Stimulus Type Subspecies:

Subspecies 2a - Heat.  
Subspecies 2b - Voltage.  
Subspecies 2c - Current.  
Subspecies 2d - Magnetic field.  
Subspecies 2e - Electromagnetic radiation.  
Subspecies 2f - Humidity.

Deposit Type Subspecies:

Subspecies 3a - Debris shield 420.  
Subspecies 3b - Leading bearing surface(s) 430 and/or 432.

Subspecies 3c - Cavity dam 467 or 469.

Subspecies 3d - Convergent channel including 474-475, 476-477, or 478-479.

Subspecies 3e - Trailing bearing surface 438.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed subspecies in each of the three categories listed above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least independent claims 1, 29 and 32 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the subspecies that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

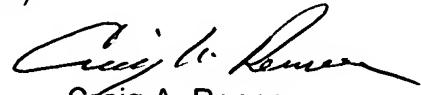
Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species/subspecies which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species/subspecies. MPEP § 809.02(a).

Should applicant traverse on the ground that the species/subspecies are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species/subspecies to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. A telephone call was made to Bryan F. Erickson on 6 March 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.
4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (703) 308-0559. The examiner can normally be reached on Tuesday-Friday 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Craig A. Renner  
Primary Examiner  
Art Unit 2652

CAR